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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,854	03/19/2004	Mark R. Slotta	1-25136	7433

4859 7590 12/14/2005

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EXAMINER

NGUYEN, JENNIFER T

ART UNIT PAPER NUMBER

2674

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/804,854

Applicant(s)

SLOTTA, MARK R.

Examiner

Jennifer T. Nguyen

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of (Patent No. US 5,889,508) in view of Katayama et al. (Patent No. US 5,349,263).

Application 10/804,854 (Slotta) (claims 1 and 3)	Patent No. US 5,889,508 (Slotta) (claim 1)
A cushion for a cursor control stick	A cushion for a control stick of a computer
A lower portion, said lower portion defining a recess for receiving at least a portion of a cursor control stick	A first end of said cushion defining a recess in said cushion, said recess being sized to accommodate at least a portion of said control stick

An upper portion, said upper portion including a generally radially outwardly extending flange formed thereon	A second end of said cushion being formed of a soft material
Upper portion formed from a first material	

Regarding claim 1, Slotta (Patent No. US 5,889,508) teaches all the limitation except the upper portion including a generally radially outwardly extending flange.

Katayama teaches a cap member (80) has a flange (83) formed on an outer periphery of the cap member (col. 4, lines 15-16, fig. 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the flange as taught by Katayama in the system of Slotta in order to allow a cursor is rapidly moved by the cursor control stick.

3. Claims 1-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of (Patent No. US 6,606,084) in view of Katayama et al. (Patent No. US 5,349,263).

Application 10/804,854 (Slotta) (claims 1 and 3)	Patent No. US 6,606,084 (Slotta) (claim 1)
A cushion for a cursor control stick	A cushion for a control stick of a computer
A lower portion, said lower portion defining a recess for receiving at least a portion of a cursor control stick	A first end of said cushion defining a recess in said cushion, said recess being sized to accommodate at least a portion of said control stick therein

An upper portion, said upper portion including a generally radially outwardly extending flange formed thereon	A second end of said cushion being formed of a soft material
Upper portion formed from a first material	

Regarding claim 1, Slotta (Patent No. US 6,606,084) teaches all the limitation except the upper portion including a generally radially outwardly extending flange.

Katayama teaches a cap member (80) has a flange (83) formed on an outer periphery of the cap member (col. 4, lines 15-16, fig. 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the flange as taught by Katayama in the system of Slotta in order to allow a cursor is rapidly moved by the cursor control stick.

4. Claims 1-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of (Patent No. US 6,621,485) in view of Katayama et al. (Patent No. US 5,349,263).

Application 10/804,854 (Slotta) (claims 1 and 3)	Patent No. US 6,621,485 (Slotta) (claim 1, 7)
A cushion for a cursor control stick	A cushion for a control stick of a computer
A lower portion, said lower portion defining a recess for receiving at least a portion of a cursor control stick	A first end of said cushion defining a recess in said cushion, said recess being sized to accommodate at least a portion of said control stick therein

An upper portion, said upper portion including a generally radially outwardly extending flange formed thereon	A second end of said cushion being formed of a gel material
Upper portion formed from a first material	

Regarding claim 1, Slotta (Patent No. US 6,621,485) teaches all the limitation except the upper portion including a generally radially outwardly extending flange.

Katayama teaches a cap member (80) has a flange (83) formed on an outer periphery of the cap member (col. 4, lines 15-16, fig. 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the flange as taught by Katayama in the system of Slotta in order to allow a cursor is rapidly moved by the cursor control stick.

5. Claims 1-20 rejected on the ground of nonstatutory double patenting over claims 1-103 of U. S. Patent No. 6,724,369 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Application 10/804,854 (Slotta) (claim 1)	Patent No. US 6,724,369 (Slotta) (claim 47)
A cushion for a cursor control stick	A cushion for a control stick of a computer
A lower portion, said lower portion defining a recess for receiving at least a portion of a	A lower portion, said lower portion defining a recess for receiving at least a portion of a

cursor control stick	cursor control stick
An upper portion, said upper portion including a generally radially outwardly extending flange formed thereon	An upper portion, said upper portion including a generally radially outwardly extending flange formed thereon

Application 10/804,854 (Slotta) (claim 11)	Patent No. US 6,724,369 (Slotta) (claim 79)
A cushion for a cursor control stick	A cushion for a control stick of a computer
A lower portion, said lower portion defining a recess for receiving at least a portion of a cursor control stick	A lower portion, said lower portion defining a recess for receiving at least a portion of a cursor control stick
An upper portion, said upper portion including a generally radially outwardly extending flange formed thereon, wherein said upper portion includes an upper surface, wherein at least a portion of said upper surface is textured	An upper portion, said upper portion including a generally radially outwardly extending flange formed thereon, said upper portion having an open pattern texture formed thereon

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engle et al. (Patent No. US 5,889,507) in view of Katayama et al. (Patent No. US 5,349,263).

Regarding claim 1, Engle teaches a cushion for a cursor control stick (i.e., joystick Assembly, fig. 5A), said cushion comprising:

a lower portion (i.e., a portion below the tip 254, fig. 5B), said lower portion defining a recess for receiving at least a portion of a cursor control stick (i.e., shaft 250); and  
an upper portion (i.e., joystick tip 254) (col. 9, lines 60-65).

Engle differs from claim 1 in that he does not specifically teach the upper portion including a generally radially outwardly extending flange formed thereon.

Katayama teaches a cap member (80) has a flange (83) formed on an outer periphery of the cap member (col. 4, lines 15-16, fig. 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the flange as taught by Katayama in the system of Engle in order to allow a cursor is rapidly moved by the cursor control stick.

8. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engle et al. (Patent No. US 5,889,507) in view of Katayama et al. (Patent No. US 5,349,263) and further in view of Selker et al. (Patent No. US 5,798,754).



Regarding claims 2 and 3, the combination of Engle and Katayama differs from claims 2 and 3 in that it does not specifically teach each portion is formed at least one of silicone gels, thermoplastic rubber compounds, and thermoplastic elastomeric compounds.

Selker teaches the outer surface of cap is formed of thermoplastic rubber compounds (col. 2, lines 46-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the material as taught by Selker in the system of the combination of Engle and Katayama in order to avoid the outer surface becoming slippery.

9. Claims 4-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engle et al. (Patent No. US 5,889,507) in view of Katayama et al. (Patent No. US 5,349,263) and further in view of Kline (Patent No. US 4,565,460).

Regarding claims 4-7 and 14-17, the combination of Engle and Katayama differs from claims 4-7 and 14-17 in that it does not specifically teach an open pattern texture is formed on at least a portion of said upper portion, said open pattern texture includes at least one nub.

Kline discloses a plurality of raised nubs (22), which extends substantially perpendicular to said second end (18), and a plurality of raised ridges (figs. 3-10, col. 3, lines 26-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the a plurality of raised nubs and a plurality of raised ridges as taught by Kline in the system of the combination of Engle and Katayama in order to provide a more non-slip surface of soft material of the cushion.

Regarding claims 11 and 13, Engle teaches a cushion for a cursor control stick (i.e., joystick assembly, fig. 5A), said cushion comprising:

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a lower portion (i.e., a portion below the tip 254, fig. 5B), said lower portion defining a recess for receiving at least a portion of a cursor control stick (i.e., shaft 250); and

an upper portion (i.e., joystick tip 254) (col. 9, lines 60-65).

Engle differs from claims 11 and 13 in that he does not specifically teach the upper portion including a generally radially outwardly extending flange formed thereon and wherein said upper portion includes an upper surface, wherein at least a portion of said upper surface is textured.

Katayama teaches a cap member (80) has a flange (83) formed on an outer periphery of the cap member (col. 4, lines 15-16, fig. 7).

Kline discloses the upper surface has a plurality of raised nubs (22), which extends substantially perpendicular to said second end (18), and a plurality of raised ridges (figs. 3-10, col. 3, lines 26-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the flange as taught by Katayama in the system of Engle in order to allow a cursor is rapidly moved by the cursor control stick and to incorporate the a plurality of raised nubs and a plurality of raised ridges as taught by Kline in the system of the combination of Engle and Katayama in order to provide a more non-slip surface of soft material of the cushion.

Regarding claims 8-10, 12, the combination of Engle, Katayama, and Kline teaches open pattern texture is formed on a generally convex/ concave/ flat surface of the cushion (figs. 1-8A of Kline).

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Regarding claim 18, Engle teaches said upper portion and said lower portion are integrally formed (fig. 7A).

Regarding claim 19, the combination of Engle, Katayama, and Kline a portion of said upper portion is generally frustoconical (figs. 1 –8A of Kline).

Regarding claim 20, Engle teaches said cushion is generally mushroom-shaped (fig. 5B).


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer T. Nguyen whose telephone number is 571-272-7696. The examiner can normally be reached on Mon-Fri: 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick N. Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Nguyen  
12/6/05

  
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SUPERVISORY PATENT EXAMINER